

REMARKS

Claims 1-9, 11-14, 16-20, 23, 24, 26-31, and 33-51 were pending as of the action mailed on January 23, 2009. Claims 1, 9, 13, 30, 38, 42, and 50 are in independent form.

Reconsideration of the action is respectfully requested in light of the foregoing amendments and the following remarks.

Claims 1-7, 9-10, 12-14, 16-17, 19, 23-24, 26-28, 30-31, 33-36, 38-39, 41-46, 48, and 50 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0010746 ("Jilk") in view of Dusse et. al., *S/MIME Version 2 Message Specification*, THE INTERNET ENGINEERING TASK FORCE REQUEST FOR COMMENTS: 2311, March 1998, <http://www.ietf.org/rfc/rfc2311.txt> ("Dusse") in view of U.S. Patent No. 6,078,951 ("Pashupathy").

Claims 8, 11, 18, 20, 29, 37, 40, 47, 49, and 51 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jilk, Dusse and Pashupathy as applied to claim 1, and further in view of ADOBE SYS. INC., PDF REFERENCE (2d ed. 2000), <http://www.adobe.com/devnet/pdf/pdfs/PDFReference13.pdf> ("PDF Reference").

Section 103 Rejections

Claim 1 was rejected as being unpatentable over Jilk and Dusse in view of Pashupathy. Claim 1 recites a first application's instructions to perform operations on a client including using a second application on the client distinct from the first application to transmit the first container object to a recipient's address, wherein the second application is an e-mail client application or a Web browser application. Thus, claim 1 clearly requires that the first application uses the second application.

With respect to the first application, the examiner states:

Regarding Claim 1 : First application on a client to generate a first container object with a recognizable container type which is associated with the first application (Jilk paragraphs 17-18, 21, 23, 97; 2312 section 2.2,2.3) The process of utilizing S/MIME dictates that certificates are exchanged prior to communication in order to provide for the secured communications. This process clearly creating a container with a plugin (1st application), which contains the

sender's certificate and a request for a recipient's certificate. The 2nd application in this case considered to be an email program (Office Action, page 4).

The examiner further states that Jilk discloses the claimed second application as an e-mail application at Figures 3A and 3B and paragraph 0096, lines 9-30, and paragraph 0097.

The examiner attempts to clarify the first application on page 2 of the office action stating:

As per the examiners rejection below, the first application is an encryption application along the lines of the S/MIME authentication scheme (Dusse). The second application is the email web application that transmits the container object formed by the S/MIME application to a recipients address (Pashupathy).

The applicant respectfully disagrees. None of the cited portions of the references relied upon by the examiner disclose or suggest an "encryption application" identified by the examiner. In claim 1, the first application uses a second application on the client distinct from the first application to transmit the first container object to a recipient's address. However, nothing in the cited portions disclose or suggest such a first application. In particular, the examiner cites a number of paragraphs in Jilk and parts of the Dusse standard.

However, on page two of the Office Action, the examiner simply relies on some application "along the lines of S/MIME authentication scheme". Dusse, however, does not identify applications. Moreover, the examiner doesn't identify any specific disclosure or suggestion in Dusse of such an application. Instead Dusse simply provides the S/MIME technical specification that describes a secure MIME data format. No applications for performing authentication using the S/MIME format are disclosed. Dusse does not disclose or suggest any application for generating containers. Moreover, Dusse does not disclose or suggest that the application includes instruction to use a second distinct application to send the container, as required by claim 1.

Regardless of whether or not the S/MIME specification contemplates a plugin to create a container (as the examiner contends), this does not disclose or suggest an application that has instructions to use another application. The examiner provides no evidence in support of this contention and therefore appears to be making a factual assertion. Such a factual assertion, when challenged, requires the examiner to provide evidentiary support as required by MPEP 2144.03)

In particular, there is nothing in the cited portions of the S/MIME specification that discloses or suggests that there is some application that creates a container. Nor is there any disclosure or suggestion in the cited portion that the application then uses another application to send the container (i.e., that a S/MIME plugin includes instruction to use an e-mail application to send a container). The applicant respectfully submits that the examiner must provide evidentiary support for these assertions as required by MPEP 2144.03.

Furthermore, the examiner states that "Pashupathy teaches a plugin application to allow an application regarding MIME containers to be used in conjunction with a web browser email program" (Office Action, page 4). In particular, the examiner cites col. 1, lines 24-32 and col. 4, lines 30-60. The applicant respectfully disagrees. Pashupathy discloses a number of different viewer plugins for viewing different types data including MIME data. *See* col. 4, lines 28-64. MIME is simply a standard for presenting data. A plugin for viewing MIME data simply presents the MIME content to a user and does not generate a container object. Thus, the cited portions of Pashupathy simply disclose that there are plugins to view different types of data.

The applicant respectfully submits that there is no disclosure or suggestion in Pashupathy that the plugin generates any container object. Furthermore, there is no disclosure or suggestion in Pashupathy that the viewer plugin is a distinct application that includes instructions to use a second application to send the container. More particularly, this would not make sense in the context of a viewer. Thus, Pashupathy does not disclose or suggest the claimed first application.

The cited portions of Jilk (paragraphs 17-18, 21, 23, 97) also fail to disclose or suggest the claimed first application. Paragraphs 17-18 and 21 simply disclose that an e-mail application can interact with HTML content provided by a server. Thus, this is interaction between an e-mail application of a client (identified by the examiner as the second application) and a remote server. Paragraph 23 states that e-mail can use a MIME format to display data. Finally, paragraph 97 states that user can transmit a URL request or form data using the e-mail application. There is no disclosure or suggestion in any of these paragraphs of any application other than the e-mail application. There is also no disclosure or suggestion of S/MIME or any application using S/MIME. Furthermore, there is no disclosure or suggestion of any application that includes instructions to use a second distinct application to send the container object generated by the first application.

Thus, it is unclear how the cited paragraphs relate at all to the claim feature. The applicant further notes that the examiner simply cites to a number of paragraphs of Jilk without explaining their pertinence. The examiner does not specifically point out how those paragraphs teach the claimed first application. In particular, the examiner does not identify either the first application or any disclosure identifying how the first application has instructions to use the second application to send the container, as required by claim 1.

The examiner considers each claim feature in isolation without considering the claim as a whole. Consequently, the examiner fails to consider the interaction between the first application and second application required by claim 1. As such, the cited references alone or in combination fail to disclose or suggest a first application that generates a container and includes instructions to use a second distinct application to send the container.

Claim 1 also recites automatically obtaining a second container object from the second application, the second container object having been received by the second application and the second container object having the same recognizable container type as the first container object. The examiner states that Jilk discloses the claimed automatic obtaining of a second container object from the second application at paragraph 0097. The applicant respectfully disagrees.

Paragraph 0097 of Jilk reads as follows:

Referring now to FIG. 3B, a method 301 is shown. In step 306, a first Web page is sent to a first email address as a first email message. The first Web page includes one or more links or form controls that provide for further interaction by a user, and is in a format consistent with one or more properties of a first email environment. That format is such that the first Web page is directly operable in an email client, for example an instance of an email browser of the first email environment. The method now proceeds with one or more steps of method 300. The user transmits a URL request or form data via email (step 303), e.g., in response to the user operating the received first Web page, and the method retrieves the request email (step 305). In one embodiment, the email is preprocessed (step 307), for example by interpreting the URL request or form data. A Web page is retrieved according to the request email (step 309). The resulting Web page is transcoded (step 311); and transmitted via email (step 313).

Specifically, the cited portion of Jilk discloses a user transmitting a URL request or form data using an e-mail application. However, Jilk does not disclose or suggest automatically obtaining a second container object from the second application, as required by claim 1. In

particular, claim 1 recites that it is the first application that automatically obtains the second container. However, the examiner's analysis simply states that "the email application clearly receives any response from WinSock wherein the container object type is of a standard email format" (Office Action, page 5). This does not reference the first application at all. It is the first application that obtains the second container from the second application. The Examiner only identifies the second application (e-mail) as receiving the container. Thus, the Examiner has entirely failed to address this feature of claim 1.

Claim 1 specifically requires that the first application include instructions to use the second application. Claim 1 also specifically recites that the first application automatically obtain a second container received by the second application. However, the examiner does not identify these features as present in Jilk, Dusse, or Pashupathy. Instead the examiner simply argues that the first application exists without identifying where the references specifically disclose the first application and without identifying where the cited references disclose that the first application includes instructions to use the second application. The Examiner also argues that the second application obtains the second container rather than the first application, as required by claim 1. Consequently, the examiner fails to make a *prima facie* case for obviousness under Section 103.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [MPEP § 2142 (emphasis added)]

As set forth above, the examiner has failed to show that the actual claim limitations are taught or suggested by the references. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (emphasis

added). Therefore, the applicant respectfully submits that claim 1, as well as claims 2-8, which depend from claim 1, are in condition for allowance.

The applicant respectfully submits that claim 1, as well as claims 2-8, which depend from claim 1, are allowable for this additional reason.

Claims 9 and 13

Claims 9 and 13 recite features corresponding to claim 1 and were rejected for the same reasons. Therefore, for the reasons set forth above with respect to claim 1, claims 9 and 13 are also in condition for allowance. Likewise, claims 11-12, which depend from claim 9, and claims 14, 16-20, 23-24, and 26-29, which depend from claim 13, are also in condition for allowance.

Claims 30, 38, 42, and 50

Claims 30, 38, 42, and 50 recite a first application that generates a first container object and a second distinct application that transmits the first container object to a recipient. As set forth above with respect to claim 1, the examiner has failed to identify a first application that generates a first container object. Therefore, for the same reasons as set forth above with respect to claim 1, claims 30, 38, 42, and 50 are also in condition for allowance. Likewise, claims 31 and 33-37, which depend from claim 30, claims 39-41, which depend from claim 38, claims 43-49, which depend from claim 42, and claim 51, which depends from claim 50, are also in condition for allowance.

Claims 30, 38, 42, and 50 further recite automatically recognizing, using the second application, that the container type is associated with the first application. The examiner states that Dusse discloses the automatic recognition, citing numerous sections. In particular, the examiner states that validating a sender "inherently provides for making the determination of the presence of a certificate so as to provide for verifying the signature or decrypting the message". However, the examiner, as well as the cited portions of Dusse, fail to address the claim language. Claims 30, 38, 42, and 50 do not recite identifying that a container exists or the contents of the container. Instead, claims 30, 38, 42, and 50 recite that the second application automatically recognizes that the container type is associated with the first application. The cited portions of Dusse do not disclose or suggest an application that recognizes a container as being associated with another application. Therefore, claims 30, 38, 42, and 50 are allowable for at least this additional reason.

Conclusion

For the foregoing reasons, the applicant submits that all the claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the applicant's decision to amend or cancel any claim should not be understood as implying that the applicant agrees with any positions taken by the examiner with respect to that claim or other claims.

It is believed that no fees are due with this filing. Please apply any other credits or charges to Deposit Account No. 06-1050.

Respectfully submitted,

Date: March 23, 2009

/Brian J. Gustafson/

Brian J. Gustafson

Reg. No. 52,978

Customer No. 21876

Fish & Richardson P.C.

Telephone: (650) 839-5070

Facsimile: (877) 769-7945